

REMARKS

Claims 1-18 are canceled without prejudice or disclaimer, having been rewritten in better form and sequence as claims 19-36. To aid the Examiner in interpreting the remarks made herein with respect to the original grounds of rejection, the table below summarizes correspondence between the canceled claims and the newly added claims.

<i>Canceled Claim</i>	<i>New Claim</i>
1	19
2	20
3	21
4	22
5	23
6	24
7	25
8	27
9	26
10	28
11	29
12	30
13	31
14	32
15	33
16	35
17	34
18	36

Applicants have thoroughly reviewed the outstanding Office Action, including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims are believed to be patentable over the cited references. No new matter is added herein.

Rejections Under 35 U.S.C. § 112

The Examiner rejects claims 4 and 17 under 35 U.S.C. § 112, second paragraph, for indefiniteness. In light of the amendments made above, Applicants submit that these rejections have been overcome, and accordingly respectfully request their withdrawal.

Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 1-6 (19-24), 9-11 (26, 28, and 29), 13-15 (31-33), and 18 (36) under 35 U.S.C. § 103 as obvious over U.S. Patent No. 2,397,726 to Cook ("Cook") in view

of U.S. Patent No. 2,775,187 to McClurkin (“McClurkin”). The Examiner rejects claim 7 (25) as obvious over Cook and McClurkin in view of U.S. Patent No. 5,461,878 to Moore et al. (“Moore”). Claim 12 (30) stands rejected as obvious over Cook and McClurkin in view of U.S. Patent No. 1,819,231 to Crawford et al. (“Crawford”). The Examiner rejects claims 8 (27) and 16 (35) over Cook and McClurkin in view of U.S. Patent No. 5,425,793 to Mori et al. (“Mori”). Claim 17 (34) is rejected over Cook and McClurkin in view of U.S. Patent No. 6,595,429 to Carlson et al. (“Carlson”). To establish a *prima facie* case of obviousness, the Examiner must demonstrate some suggestion or motivation to combine one or more references, with a reasonable expectation of success, to teach each and every claimed limitation. MPEP § 2142. Applicants submit that the Examiner has failed to meet this standard.

Claim 19 recites

A climatic cabinet, comprising:

- an interior *configured to hold specimen slides*;
- a transporting device *to load and unload the interior* with the specimen slides;
- a loading opening for transporting the specimen slides between the interior and an exterior of the cabinet during loading and unloading thereof, said loading opening having an interior face and an exterior face, wherein said loading opening is located in a cabinet sidewall and has *dimensions substantially conforming to the specimen slides*;
- a door *adapted to tightly seal* said loading opening; and
- a gas supply system for supplying a flow of a gas proximate said loading opening, wherein said gas supply system comprises at least one gas exhaust opening proximate said loading opening configured to cover a cross-section of the loading opening with a gas curtain.

(emphasis added). The combination of Cook and McClurkin clearly does not teach a climatic cabinet “configured to hold specimen slides,” a device “to load and unload the interior” of the cabinet, a loading opening with “dimensions substantially conforming to the specimen slides,” or a door “adapted to tightly seal” the loading opening.

The present invention provides a climatic cooling cabinet for storing specimen slides. As described in the specification, the cabinet includes a loading opening that is just large enough to

permit passage of the specimen slides with the aid of a loading mechanism. The loading opening is made only as large as necessary to convey a specimen in order to avoid disturbing the environment (temperature, humidity, atmosphere, etc.) within the cabinet. To further ensure the integrity of the cabinet's internal environment, a door is provided to tightly seal the loading opening.

Cook, by contrast, teaches an oven for cooking trays of food, and thus does not disclose "an interior configured to hold specimen slides" as recited in claim 19. Though one can surmise that loading opening 12 is large enough to pass trays of food therethrough, lest the oven be rendered useless, Cook is not concerned with preserving the integrity of the cooking environment. Thus, Cook teaches nothing of the dimensions of opening 12, much less that the dimensions of the opening conform substantially to those of the trays of food. Nor does Cook disclose that door 14 covering loading opening 12 tightly seals loading opening 12. Further, even if one were to assume that Cook could be adapted for use with specimen slides instead of trays of food, Cook does not teach a transporting device for loading and unloading the interior of the oven. Rather, the operator loads trays 25 manually; the conveyor system of Cook is more akin to Applicants' carousel 5 than the claimed transporting device. The Examiner does not rely on McClurkin to cure any of these shortcomings, citing it only to teach the addition of a gas curtain. Thus, the asserted combination of references fails to teach each and every element recited in claim 19.

Applicants further contend that the asserted combination of references is improper insofar as no motivation exists to combine the two references. The mere fact that references *can* be combined is insufficient; the prior art must also suggest the *desirability* of the combination. MPEP § 2143.01. As noted above, Cook is not concerned with the loss of atmosphere from within the oven to the external environment or the imposition of external atmosphere to the interior of the oven. Thus, though such a combination is indeed possible, one having ordinary skill in the art would not be motivated to provide a gas curtain according to McClurkin at the opening of Cook's oven. It is only the improper application of hindsight in view of the present invention that would motivate one to add a gas curtain to the commercial oven disclosed in Cook.

Furthermore, Applicants submit that Cook is an improper reference. Proper references under section 103 are those from analogous arts. This requires that the reference “either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP § 2141.01(a). A commercial oven is certainly not in the same field of endeavor as a climatic cabinet for specimens. Thus, Cook is a proper reference if, and only if, it reasonably pertains to the problem addressed by the present invention. As noted above, the present invention is concerned with preserving the integrity of the atmosphere internal to a climatic cabinet. Cook, on the other hand, is concerned with cooking food in a commercial oven without regard to whether or not the atmosphere internal to the oven is disturbed. Since Cook does not concern itself with the problems addressed by the present invention, it cannot fairly be said that Cook commends itself to the Applicants’ attention. Accordingly, Cook is not from an analogous art, and cannot properly be used to sustain a rejection under section 103.

For at least the foregoing reasons, the asserted combination of references fails to establish a *prima facie* case of obviousness as to claim 19. The remaining claims depend from claim 19. Moore, Crawford, Mori, and Carlson all fail to cure the deficiencies of the combination of Cook and McClurkin with respect to claim 19, and therefore do not result in a *prima facie* case of obviousness as to the claims against which they are asserted. Applicants therefore submit that the present invention is patentably distinguished over the prior art, and accordingly respectfully request withdrawal of all rejections.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all objections and rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Docket No. 87333.3281
Serial No.: 10/766,900
Customer No. 30734

Patent

No extension of time or fee is believed necessary for the consideration of this paper. In the event an extension of time is required for this paper to be considered timely, Applicants hereby make a conditional petition for any such extensions. Please charge any fee deficiencies and credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 87333.3281.

Respectfully submitted,

BAKER & HOSTETLER LLP



Scott A. Felder
Reg. No. 47,558

Date: 23 DEC 05
Washington Square, Suite 1100
1050 Connecticut Avenue, NW
Washington, DC 20036-5304
Telephone: 202-861-1500
Direct: 202-861-1545
Facsimile: 202-861-1783